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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/855,195	05/14/2001	Raymond Jeffrey May	KCC-14,280	8182

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EXAMINER

REICHLER, KARIN M

ART UNIT	PAPER NUMBER
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3761

DATE MAILED: 09/08/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/855,195

Applicant(s)

MAY ET AL.

Examiner

Karin M. Reichle

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-- The MAILING DATE of this communication appears on the cover sheet with the correspond nc address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 19-24 and 30-35 is/are pending in the application.
- 4a) Of the above claim(s) 30-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19-24, 34 and 35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 June 2003 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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## **DETAILED ACTION**

### ***Specification***

### ***Drawings***

1. The corrected or substitute drawings were received on 6-16-03. These drawings are approved.

### ***Claim Objections***

2. Claims 19-24 and 34-35 are objected to because of the following informalities: in claim 19, second to last line, "a" should be --an associated--. Appropriate correction is required.

### ***Claim Language Interpretation***

3. For purposes of the prior art rejections the claim language "targeted elastic material" is defined as set forth at page 7, lines 4-10, i.e. the elastic is made in the same process as is the elastic material or laminate made therefrom. It is noted that the terminology "absorbent composite structure", "attached", "permanently bonded", "piece" have not been specifically defined by the Applicants and thus will be given their broadest customary interpretation, i.e. the dictionary definition, in light of the specification. As set forth on page 14, last paragraph, page 18, lines 6-19 and page 20, lines 7-8 of the specification, the absorbent composite is the cover, liner and absorbent where coextensive, the side panels may be separate pieces attached to the

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composite or integrally formed therewith, i.e. an extension of a component of the composite structure, and the targeted elastic material forms the panels, i.e. may be integrated therewith. Therefore, in light of the specification, and the dictionary definition of "composite", i.e. "made up of distinct components; compound", the terminology "absorbent composite" is defined as the absorbent and at least one other layer or component where coextensive and the "side edge" thereof being where they are no longer coextensive. The terminology "attached" and "permanently bonded" are defined as being direct or indirect permanent bonding or attaching of separate elements to form a unitary structure or direct or indirect permanent bonding or attaching so as to form a monolithic structure. "Piece" is defined as set forth by the American Heritage Dictionary as "a thing considered as a unit or element of a larger quantity or class; portion", i.e. does not have to be separate or distinct.

***Claim Rejections - 35 USC §102***

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 19-24 and 34-35 are rejected under 35 U.S.C. 102(b) as being anticipated by Van Gompel et al., EP '052.

See paragraph 3. *supra*, Figures, abstract, col. 1, lines 3-5, 19-20, 34-49, 55 et seq, col. 2, lines 10-14, col. 4, lines 14-16, 18-22, 33-39, col. 6, lines 13-51, col. 7, lines 16-54, col. 9, lines 18-

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24(and thereby col. 4, line 31-col. 5, lines 37 of '464), col. 8, line 51-col. 9, line 17 and claims, i.e., the chassis is 2, the absorbent composite is 32 and at least 52, also see Figures 6 and 7 which show such composite having linear side edges, the side panels are at least portions 10 of element 20 which are attached and permanently bonded to the composite and extend transversely beyond the side edges thereof, the leg openings are 16, the waist opening is 12, the targeted elastic material or pieces are the stretchable portions of 10 and the tension zones are disclosed at col. 7, lines 16-31. As best understood of the instant specification at page 1, last paragraph, page 2, lines 8-13 as amended, the definitions on page 7 and the manufacturing processes of Figures 9-12 and 16, at the very least the device is set forth at col. 7, lines 32-54, i.e. material or laminate made elastic in the thermal bonding process with 36, 48 which also makes 36, 48 elastic so is part of the single manufacturing process of making the zoned elastic material, i.e. the elastic or stretchable portion, e.g. 36, of the side panels 10 are the targeted elastic material pieces or portions and such are permanently bonded or attached to the composite and extend transversely beyond the side edges of the composite. It is noted that the claims also do not require the pieces extend from the side edge. The reference teaches a device which functions as set forth in claims 20-22 and 24. In claim 23, Applicant claims the device being swimwear which capability or function the reference does not explicitly teach. However, the Van Gompel patent teaches all the claimed structure. Therefore there is sufficient factual evidence for one to conclude that the properties and functions of such claimed structure would also be inherent in the same structure of the Van Gompel device. See MPEP 2112.01. With regard to claim 34 and 35, see cited portions

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supra, e.g., col. 7, lines 40-43, col. 6, lines 42-51, and col. 8, line 51-col. 9, line 23. See also response to Applicants' arguments infra.

### ***Double Patenting***

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321<sup>©</sup> may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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7. Claims 19-24 and 34-35 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-19, 21, 50-59 of copending Application No. 09/855,188 in view of Van Gompel '052 and Bunnelle et al, '123. Although the conflicting claims are not identical, they are not patentably distinct from each other because since the applications were filed on the same day the one way In re Vogel test applies, i.e. are the claims of the instant application obvious in view of the claims of the other application? The answer is yes. Note the definitions in the other application, i.e. "Disposable garment", "TEL" and "TEM", the definitions in the instant application, and claim language in both applications. The instant claims include 1) the TEM being in the side panel so as to have the one high tension zone aligned with either the leg or waist opening, a second high tension zone aligned with the other of the openings and the one low tension zone therebetween which specific gradient is in a side panel and a single manufacturing process which are not required by the claims of the other application, and the instant claims do not require 2) the specifics of claims 3-19, 51, 56 and 59 of the other application. With regard to 1), see cited portions of Van Gompel supra. To employ the claimed tension gradient in the laminate and the laminate in the side panel as taught by Van Gompel and as claimed in the instant application in the device as claimed in the other application claims would be obvious to one of ordinary skill in the art in view of the recognition that such a feature would provide improved fit and the desirability of good fit in any garment to be worn and especially a absorbent garment, i.e. don't want it to leak. Also see Bunnelle et al, col. 11, lines 3- 61, i.e. an elastic can be directly contacted with a substrate or can

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be stored and attached to the substrate later, i.e. a single manufacturing process or a non single manufacturing process. Therefore to make the manufacturing process a single process, if not already, would be obvious to one of ordinary skill in the art in view of the recognition of the interchangeability as taught by Bunnelle et al. With regard to 2), the claims of the instant application are broader with regard to those claims of the other application, i.e. they claim more specific embodiments, and once the applicant receives a patent for a more specific embodiment he is not entitled to a patent for a broader or generic invention. This is because the specific anticipates the broader, see *In re Goodman*, supra.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

8. Claims 19-24 and 34-35 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 and 49-58 of copending Application No. 09/855, 189 in view of Van Gompel and Bunnelle et al, '123. Although the conflicting claims are not identical, they are not patentably distinct from each other because since the applications were filed on the same day the one way *In re Vogel* test applies, i.e. are the claims of the instant application obvious in view of the claims of the other application? The answer is yes. Note the definitions in the other application, i.e. "Disposable garment", "TEL" and "TEM", the definitions in the instant application and claim language in both applications. The instant claims include 1) the TEM being in the side panel so as to have the one high tension zone aligned with either the leg or waist opening, a second high tension zone



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aligned with the other of the openings and the one low tension zone therebetween which specific gradient is in a side panel, a single manufacturing process, and a first and second polymer compositions which are not required by the claims of the other application and the instant claims do not require 2) the specifics of claims 2-17, 19-23, 50, 55 and 58 of the other application. With regard to 1), see cited portions of Van Gompel *supra*. To employ the claimed tension gradient in the laminate and the laminate in the side panel as taught by Van Gompel and as claimed in the instant application in the device as claimed in the other application claims would be obvious to one of ordinary skill in the art in view of the recognition that such a feature would provide improved fit and the desirability of good fit in any garment to be worn and especially a absorbent garment, i.e. don't want it to leak. Also see Bunnelle et al, col. 11, lines 3- 61, i.e. an elastic can be directly contacted with a substrate or can be stored and attached to the substrate later, i.e. a single manufacturing process or a non single manufacturing process. Therefore to make the manufacturing process a single process, if not already, would be obvious to one of ordinary skill in the art in view of the recognition of the interchangeability as taught by Bunnelle et al. With regard to the composition see discussion of claims 34-35, paragraph 7 *supra*, which rationale also applies here. With regard to 2), the claims of the instant application are broader with regard to those claims of the other application, i.e. those claims claim more specific embodiments, and once the applicant receives a patent for a more specific embodiment he is not entitled to a patent for a broader or generic invention. This is because the specific anticipates the

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broader, see *In re Goodman, supra.* is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Response to Arguments***

9. Applicants' remarks with regard to the formal matters on pages 6-7 of the 6-16-03 response have been noted but are either deemed moot in that such matters have not been reraised or do not address the remaining matters. Applicants' remarks on pages 8-9 with respect to the 103 rejection have been noted but are deemed moot in that such issue has not been reraised. Applicants' statement on page 11 has been noted and the pertinent part of the Office Action has not been reraised. Applicants' comments with respect to the provisional double patenting rejection have been noted. The Bunnelle et al reference has been further identified. The provisional rejections continue to stand since the case is not in condition for allowance and a terminal disclaimer has not been filed. Finally, Applicants' remarks on pages 7-8 with respect to the 102 rejection have been considered but are deemed nonpersuasive since such remarks are narrower than the claim language and the teachings of the prior art. For example, as noted above, the terminology "absorbent composite" does not require an outer cover, liner and absorbent nor that the side panels extend beyond a linear side edge of the outer cover. The Van Gompel reference teaches side panels which extend beyond a linear edge of a composite which includes distinct components including an absorbent, i.e. elements 32 and 52, as claimed. The claims do not require the side panels or TEM be directly permanently bonded to and extend from and beyond a linear side edge of an absorbent composite structure. Van Gompel teaches side panels which include targeted elastic material which are permanently bonded to the side edges of the composite and extend beyond such edges as claimed. Even if Applicants were to claim more specifics of the device the Popp et al reference is made of record to show that a garment such as Van Gompel '052(priority document is 809993) can have various portions which do or do not

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extend to the side seams, see Figure 10 and the paragraph bridging cols. 11-12. Such outer cover configuration is also shown as interchangeable with a configuration as shown in Figures 5-9 which show an absorbent composite and four side panels connected together.

### ***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any new grounds of rejection were necessitated by the amendments to claim 19.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to K. M. Reichle whose telephone number is 703-308-2617. The examiner can normally be reached on Monday-Thursday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo, can be reached on (703) 308-1957. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

KMR

September 2, 2003

KAREN ROACHE  
RECEIVED  
SEP 2 2003